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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/135,059	10/12/93	SEEBACHER R	233808419

DARBY & DARBY
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NEW YORK, NY 10022

35M1/1208

PITTS, A EXAMINER	
ART UNIT	PAPER NUMBER
3502	//

DATE MAILED:

12/08/95

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

**A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET
TO EXPIRE _____ MONTHS, DAYS FROM THE DATE OF THIS LETTER.**

Office Action Summary

Application No.
08/135,059

Applicant(s)
Seebacher

Examiner
Andrea L. Pitts

Group Art Unit
3502



☒ Responsive to communication(s) filed on Jul 20, 1995

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-70 ~~is/are~~ pending in the application.

Of the above, claim(s) 20, 23, 28, 31-35, and 48-68 ~~is/are~~ withdrawn from consideration.

☒ Claim(s) 36-47 would be ~~is/are~~ allowed.

☒ Claim(s) 1-19, 21, 22, 24-27, 29, 30, 36-47, 69, and 70 ~~is/are~~ rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION

This is a third office action in response to applicant's amendment and remarks filed 6-14-95 and 7-18-95. The second Office action mailed 10-02-95 was mailed after the Supplemental Amendment was received but before the paper was matched with the file. Therefor, the statutory time period has been restarted.

The objection and rejection under 35 USC 112, first paragraph, to the specification and claims, respectively, has been withdrawn and the rejection under 35 USC 102(b) of claims 36-47 has also been withdrawn due to applicant's remarks. However, a new rejection under 35 USC 112, second paragraph, has been added to claims 36-47, therefore, this action is a second action non-final.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(I). Correction of the following is required: there is no discussion of a "Fottinger coupling" as set forth in claim 3.

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Claim Rejections - 35 USC § 112

Claim 40 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 36, line 3, the phrase "connectable with a rotary driving device" and, in line 6, the phrase "connectable with a rotary driven device" renders the scope of the claim indefinite because it cannot be readily determined if applicant is actually claiming that the coupling is connected with the driving device or if the runner is connected to the driven device, respectively.

In claim 70, line 2, the phrase "connectable with a drive shaft", in lines 5 to 6, the phrase "connectable with a driven shaft" and, in lines 14 to 15, the phrase "connectable with said rotor" render the scope of the claim indefinite because it cannot be readily determined if applicant is actually claiming that the 1) the housing is connected to the drive shaft, 2) the rotor is connected to the driven shaft and 3) the output element is connected to the rotor, respectively.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-8, 18, 19, 21, 22, 24-27, 29, 30, 69 and 70 are rejected under 35

U.S.C. § 102(b) as being anticipated by Japanese Patent 54-145860.

The Japanese Patent '860 discloses a torque converter with a bypass clutch including all of the elements as set forth in applicant's claims. Please note the housing 6 connected with a rotary driving device (shaft) 1, 2; a carrier (hub) 26 which contains stressing means 27, 28 connected to the runner 10 by a weld for rotating therewith and a confining portion 24 radially outwardly adjacent the energy storing element; a runner 10 disposed in the housing and connected to a rotary driven device (shaft) 13 via hub 12; a torsionally elastic damper means 25 for transmitting power between the housing 6 and the driven device 13, wherein the torsion elastic means includes at least one energy storing device acting in a circumferential direction of the impeller 8 between the runner 10 and the driven device 13 via hub 12 and piston 15 and the energy storing device is spaced apart from and disposed radially outwardly of the axis of rotation X-X. The Japanese Patent also includes a guide wheel 11; said driving device 1 which includes an output element 2 of an engine; said

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driven device 13 which includes an input element of a transmission; and said housing which includes a wall 6 adjacent the driving device 2, wherein the power transmitting device is disposed between the wall and the runner 10. The damper includes an output member (piston) 15 which is axially movable and an output element 21 arranged to transmit torque to the driven device 13 which is nonrotatably connected with an output member.

Claims 1-8, 11-17, 22-25 and 69 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Friedmann et al. 5,377,796.

Friedmann et al. discloses all of the elements as set forth in applicant's claims. Please note the wear resistance member 23 and the torsion damping spring 20 which is preformed into a curved shape and extends along an arc between 90° and 175°.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed

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invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 9 and 10 are rejected under 35 U.S.C. § 103 as being unpatentable over Friedmann et al. 5,377,796.

Friedmann et al. discloses all of the limitations as set forth in applicant's claims as noted in the rejection under 35 USC 102(e) except there is no indication of the spring gradient of the preformed curved springs 20. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the optimum range of the spring gradient, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

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Allowable Subject Matter

Claim 36-47 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112 and to include all of the limitations of the base claim and any intervening claims.

The following is an Examiner's statement of reasons for the indication of allowable subject matter: the prior art of record does not reveal or render obvious a power transmitting apparatus having all of the elements as set forth in the independent claim specifically including the combination of the stressing means for stressing the elastic damper which is connected with a runner for joint movement about and along the axis, wherein the runner is connected with a rotary driven device and is movable relative to the output element in the direction of the axis.

Response to Amendment

Applicant's arguments filed 6-14-95 have been fully considered but they are not deemed to be fully persuasive.

Applicant argues that "Fottinger coupling" is an well known term in the art and therefore the rejection under 35 USC 112 should be withdrawn.

However, if applicant fully read the rejection he would have noted that the examiner is not disputing the fact that "Fottinger coupling" is well known, only that applicant has not provided any support in the specification for the use of the term in

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the claims. To clarify the examiner's position, the objection to the specification and the rejection to claim 3 under 35 USC 112, first paragraph, have been withdrawn and a new objection to the specification under 35 USC 112, second paragraph, has been added. The reasoning remains the same and applicant's duty to correct the specification also remains.

Applicant further argues that the Toyota '860 does not disclose an energy storing element disposed in a power train between a runner and a driven device, but that the Toyota reference disclose the energy storing element between the runner and the piston.

However, it appears that applicant's arguments are directed to Figure 1 of the present applicant. This Figure was restricted in paper no. 4 and non-elected by applicant in paper no. 5. Figures 2 and 3 were the elected figures. Figure 2 clearly shows the same features as shown in the Toyota reference, that, when locked up, the spring 125 is connected to the runner 113 and the housing 112 which is attached to the driven device (the engine, not numbered). Toyota shows a spring 25 attached to the runner 10 such that, when locked up, the spring is connected to the runner 10 and the housing 6 which is attached to the ^{driving} driven-device (the engine) 1, 2. The spring must be attached to the ^{driven} driven member when the bypass clutch is in the locked up state in order for the ^{driven} driven member to drive the ^{driving} driving member with a 1:1 ratio, i.e., bypassing the variable torque output of the impeller and turbine. A more detailed

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description has been given in the rejection under 35 USC 102(b) to clarify the examiner's position.

Applicant's arguments with respect to claims 36-47 have been considered but are deemed to be moot in view of the withdrawal of the rejection to these claims and the indication of allowable subject matter.

Applicant also argues that Friedmann et al. does not disclose the energy storing elements operating between the runner and the driven device as claimed by applicant.

However, if applicant refers to Figures 7, 8 and 10-12 of Friedmann et al., the various torque converters, when in the locked up state, clearly show the spring in a power flow connection between the runner 336 and the driven device 4, 5 via housing 307 just as in applicant's elected species. The spring maintains an engagement with the housing and is selectively engageable with the turbine runner shell 336 at 338 thus causing a 1:1 torque transfer between the driven and driving devices through the runner and bypassing the variable torque output transmitted by the impeller and turbine.

With respect to applicant's request that the indication of the relevancy of cited prior art not used in any rejections be noted as having only "somewhat similar characteristics as in applicant's present invention" is noted. Such indication is redundant because the use of the word "similar" indicates that the references are not the "same as" applicants disclosed invention. Also "somewhat" is a relative term that

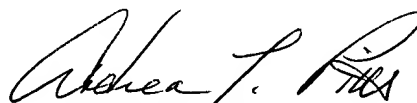
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neither adds nor subtracts to the meaning of the statement. Therefore, the statement as originally written remains.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea L. Pitts whose telephone number is (703) 308-2159.

A handwritten signature in black ink, appearing to read "Andrea L. Pitts", with a stylized flourish at the end.

Andrea L. Pitts
Primary Examiner,
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Pitts/alp
November 27, 1995